UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/023,447	KUISMA ET AL.
	Examiner	Art Unit
	Patrice Winder	2445

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _12 May 2009_.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-19_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-19_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _17 December 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All b) ☐ Some * c) ☐ None of:
      1. ☒ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114 was filed in this

application after a decision by the Board of Patent Appeals and Interferences, but

before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or

the commencement of a civil action. Since this application is eligible for continued

examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution

in this application has been reopened pursuant to 37 CFR 1.114. Applicant's

submission filed on May 12, 2009 has been entered.

Response to Arguments

2.   Applicant's arguments filed May 12, 1999 have been fully considered but they are

not persuasive.

3.   Applicant continues to argue the merits of the 3GPP and Zahariv references and

the present claims without addressing the amendments.

     a.   Applicant is reminded of the res judicata effect of a Board of Patent

     Appeals and Interferences decision in an application (see MPEP § 706.03(w)), a

     Board decision in an application is the "law of the case," and is thus controlling in

     that application and any subsequent, related application. Due to res judicata only

     applicant's arguments to the amendments will be considered and addressed.

b.   In response to applicant's arguments, the recitation "actual multimedia

messages" has not been given patentable weight because the recitation occurs

in the preamble. A preamble is generally not accorded any patentable weight

where it merely recites the purpose of a process or the intended use of a

structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and

Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4.   Applicant argues – The 3GPP-Zahariev combination does not teach "multimedia

messages for which a notification message has been sent and an acknowledgement

message from the terminal has not been received".

c.   The transport protocol that serves the 3GPP system is TCP/IP. By

function, TCP/IP retransmits message (and packets) that are not acknowledged.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1, 3-5, 7-10, 12, 14-15 and 19 are rejected under 35 U.S.C. 102(a) as

being anticipated by "3rd Generation Partnership Project; Technical Specification Group

Terminals; Multimedia Messaging Service (MMS); Functional Description; Stage 2, (3G

TS 123.140 version 1.0.0)" hereinafter referred to as 3GPP in view of Zahariev (U.S.

6,035,104).

As per claims 1, 9, 10, 12, and 14-15, 3GPP teaches: transmitting a first

message wirelessly from the terminal to the multimedia messaging centre, the first

message requesting the multimedia messaging centre to transmit a notification

message to the terminal on multimedia messages addressed to the terminal which have

arrived at the multimedia messaging centre and on which the terminal has not received

a notification message yet (section 8.3.3 on page 17, Figure 11 on page 19, and

paragraphs 1-2 on page 20 under Annex A) and multimedia messages for which a

notification message has been sent and an acknowledgement message from the

terminal has not yet been received by the multimedia messaging center (page 10,

Section 5: Protocol Framework, "The MM transfer protocol A shall be implemented

using MExE [4] (e.g. Java and TTCP/IP) or WAP [5]." TCP/IP is the transfer protocol

and TCP/IP by standard teaches retransmitting non-acknowledged message, e.g. notifications).

3GPP does not explicitly teach: wherein said first message comprises an option to define a selection criterion so as to limit information to be sent in response to said first message. However, Zahariev discloses: "The here-presented system provides an ability to selectively filter information based on e-mail, and to notify a subscriber of availability of such selected information, giving the subscriber an option to have the message forwarded either by e-mail or fax to a specific location," (line 64 of column3 through line 1 of column 4). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have the first message comprise an option to define a selection criterion so as to limit information to be sent in response to said first message. "Once a message is received that matches the criteria, the subscriber will receive a page that could look l!ke:MsgID=1234, Filter1. The subscriber then can call the Auto Attendant and identify himself with Customer ID and password, upon which he will be prompted to enter the message ID. Next he can select means of delivery, like e-mail or fax, and then enter numbers or addresses, or select one of a limited set of preprogrammed numbers or addresses," (lines 8-14 of column 4 in Zahariev). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the first message comprise an option to define a selection criterion so as to limit information to be sent in response to said first message in the system as taught by 3GPP.

As per claim 3, 3GPP teaches: receiving the first message transmitted by the terminal at the multimedia messaging centre; determining at the multimedia messaging centre whether there are multimedia messages addressed to the terminal at the multimedia messaging centre on which the terminal has not received a notification message yet; transmitting a second message from the multimedia messaging centre to the terminal in response to the first message, the second message containing the notification messages on said multimedia messages on which the terminal has not received a notification message yet (section 8.3.3 on page 17, Figure 11 on page 19, and paragraphs 1-2 on page 20 under Annex A).

As per claim 4, 3GPP teaches: receiving the second message at the terminal, which has been transmitted by the multimedia messaging service and contains said notification messages (Figure 11 on page 19 and paragraph 2 on page 20 under Annex A); transmitting a third message from the terminal to the multimedia messaging centre in response to said second message, the third message indicating to the multimedia messaging centre the terminal's desire to fetch the multimedia message on which a notification message was transmitted to the terminal in said second message (Figure 12 on page 20 and paragraph 3 on page 20 under Annex A).

As per claim 5, 3GPP teaches: receiving the third message transmitted by the terminal at the multimedia messaging centre; transmitting a fourth message from the multimedia messaging centre to the terminal in response to said third message, the fourth message containing the multimedia message which the terminal desires to fetch as indicated in said third message (Figure 12 on page 20 and paragraph 3 on page 20).

As per claim 7, 3GPP teaches: it is determined at the multimedia messaging centre whether the multimedia messaging centre has multimedia messages addressed to the terminal for which the terminal has not received a notification message by investigating whether the multimedia messaging centre has received an acknowledgement to the notification message from the terminal (Figure 12 on page 20 and paragraph 3 on page 20 under Annex A).

As per claim 8, 3GPP teaches: means for receiving a first message transmitted by the terminal, the first message requesting the multimedia messaging centre to transmit a notification message to the terminal for multimedia messages addressed to the terminal that have arrived at the multimedia messaging centre and for which the terminal has hot received a notification message yet (section 8.3.3 on page 17, Figure 11 on page 19, and paragraphs 1-2 on page 20 under Annex A); and means for determining whether there are multimedia messages addressed to the terminal at the multimedia messaging centre for which the terminal has not received a notification message yet (paragraphs 1-2 on page 23 and Figure 17 on page 23).

As per claim 19, 3GPP taught that each of the first, second and fourth messages are a certain message type, the message type indicating to a receiving device how to process a respective message (each message type in interpreted by receiving device, Figure 8 on page 16, 7.3 WAP Transaction Flows Supporting MMS).

7.   Claims 2, 11, 13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP and Zahariev as applied to claims 1 and 8 above, in view of Skladman et al. (U.S. 6,400,810 B1) hereinafter referred to as Skladman.

As per claims 2, 13, and 16, 3GPP does not explicitly teach: the first message requests the multimedia messaging center to transmit a notification message to the terminal for multimedia messages, addressed to the terminal, that have arrived at the multimedia messaging center and for which the terminal has not received a notification message transmitted from the multimedia messaging center. However, Skladman discloses: "When used in conjunction with an e-mail service, a notification service provides a messaging system that quickly and conveniently notifies subscribers of received e-mail messages without requiring the subscribers to remain at their computers. Upon receiving notification, subscribers can access the e-mail system at their discretion to review any new e-mail messages," (lines 42-48 of column 1). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have the first message request the multimedia messaging center to transmit a notification message to the terminal for multimedia messages, addressed to the terminal, that have arrived at the multimedia messaging center and for which the terminal has not received a notification message transmitted from the multimedia messaging center. "To facilitate timely and convenient notification of incoming e-mail messages, an e-mail system can operate in conjunction with a notification system. A notification system is a computer-based communication system that can transfer messages to a subscriber, notifying him/her of particular events, such as the receipt of new e-mail messages," (lines 27-32 of column 1 in Skladman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the first message request the multimedia messaging center to

transmit a notification message to the terminal for multimedia messages, addressed to the terminal, that have arrived at the multimedia messaging center and for which the terminal has not received a notification message transmitted from the multimedia messaging center in the system as taught by 3GPP and Zahariev.

As per claim 11, 3GPP does not explicitly teach: wherein the selection criterion defines that notification messages for only those multimedia messages for which a notification message has not been successfully transmitted are requested. However, Skladman discloses: "When used in conjunction with an e-mail service, a notification service provides a messaging system that quickly and conveniently notifies subscribers of received e-mail messages without requiring the subscribers to remain at their computers. Upon receiving notification, subscribers can access the e-mail system at their discretion to review any new e-mail messages," (lines 42-48 of column 1). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have the selection criterion define notification messages for only those multimedia messages for which a notification message has not been successfully transmitted are requested. "To facilitate timely and convenient notification of incoming e-mail messages, an e-mail system can operate in conjunction with a notification system. A notification system is a computer-based communication system that can transfer messages to a subscriber, notifying him/her of particular events, such as the receipt of new e-mail messages," (lines 27-32 of column 1 in Skladman). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have the selection criterion define notification messages

for only those multimedia messages for which a notification message has not been successfully transmitted are requested in the system as taught by 3GPP and Zahariev.

8.   Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP and Zahariev. Claim 17 contains similar limitations as those in claims 1 and 2 and is rejected under the same rationale.

9.   Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP and Zahariev as applied to claim 5 above, in view of Short et al. (U.S. 6,130,892) hereinafter referred to as Short.

As per claim 6, 3GPP fails to teach: the terminal and the multimedia messaging centre comprise a protocol stack and a multimedia application on top of it, and said first, second, third and fourth messages are transmitted at the level of the multimedia application, the messages then being independent of the implementation of the protocol stack below the multimedia application. However, Short discloses: "The translation of the packets is done not just at the physical, link, or network layer of the protocol stack but at the transport and application layers as well. This allows the network card, protocol stack, and application running on the host computer to be independent of the network environment and configuration," (line 64 of column 3 through line 2 of column 2). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have the terminal and the multimedia messaging centre comprise a protocol stack and a multimedia application on top of it, and said first, second, third and fourth message are transmitted at the level of the multimedia application, the messages then being independent of the implementation of the protocol stack below the multimedia

application. "As an example of the communication device independence, the translation

allows soft handoff, increased throughput, and fault tolerance by supporting multiple

communication substrates. In addition, the nomadic router translation ability provides a

flexible process for deploying enhanced nomadic and mobile computing software and

services such as filtering of packets and

determining which packets should be allowed to be transmitted between the

mobile computer and the nomadic router or local area network (Internal Firewall)," (lines

3-12 in column 4 of Short). It' is for this reason that one of ordinary skill in the art at the

time of the applicant's invention would have been motivated to have the terminal and

the multimedia messaging centre comprise a protocol stack and a multimedia

application on top of it, and said first, second, third and fourth message are transmitted

at the level of the multimedia application, the messages then being independent of the

implementation of the protocol stack below the multimedia application in the system as

taught by 3GPP.

10.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP

and Zahariev as applied to claim 3 above, and further in view of Thro et al., USPN

6,147,977 (hereafter referred to as Thro).

Regarding claim 18, 3GPP and Zahariev does not specifically the first message

indicates to the multimedia messaging centre a time when the terminal wants to receive

undelivered notification messages. However, Thro taught a first message indicates to

the multimedia messaging centre a time when the terminal wants to receive undelivered

notification (subscription command for priority matrix, column 3, lines 48-60; column 4,

lines 32-39). It would have been obvious to one of ordinary skill in the art at the time the

invention was made that incorporating Thro's delivery time in 3GPP-Zahariev's

multimedia messaging system would have reduced recipient frustrations. The

motivation would have been to provide the subscriber control over incoming notifications

and thereby reduce annoyances.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Skog et al., US 20020126708 A1: taught a MMS server sends notifications to a PAP

server that sends the notifications to a recipient mobile device;

Kim et al., US 20020116465 A1: taught an Email server that receives multimedia email

and sends notification of receipt of multimedia message to the intended recipient;

Rooke et al., US 6678361 B2: taught sending a notification (MMSNotify) about the

presence of a message from the MMSC to a terminal;

Miller et al., US 6421707 B1: taught the network sends notifications to subscribers of

messages based on a profile provided by the subscriber;

Payne et al., US 6021433 A: taught a user is notified through different multimedia alerts

that an incoming message has been received at a particular computing device; and

Helferich, US 6233430 B1: taught a paging transceiver that receives notifications of

waiting multimedia messages and the user determining when to receive the multimedia

messages based on the notifications.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrice Winder/
Primary Examiner, Art Unit 2445

September 26, 2009